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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,568	06/24/2005	Kentarou Kanae	274415US0PCT	9227
22850	7590	03/23/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			TESKIN, FRED M	
			ART UNIT	PAPER NUMBER
			1713	
DATE MAILED: 03/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

CM

Office Action Summary	Application No. 10/540,568	Applicant(s) KANAE ET AL.	
	Examiner Fred M. Teskin	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-7 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information/Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>091205</u> . | 6) <input type="checkbox"/> Other: ____. |

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The Article 34 Amended Sheets filed October 21, 2004 having been entered, claims 2-7 are currently pending and under examination.

The Abstract of the Disclosure is objected to because it is not in single-paragraph format as per MPEP 608.01(b). Appropriate correction is required.

Claim 5 is objected to because of the following informalities: "calendaring" should read –calendering- (cf., Kanae et al, col. 18, line 57). Appropriate correction is required.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 is indefinite due to improper Markush language, viz., "selected from ... and/or" "Selected from the group consisting of ... and ..." is proper; see MPEP 2173.05(h). Appropriate correction is required.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,670,426, alone or in view of Kinoshita et al or Itoh et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '426 patent claims a molded product formed of an olefin thermoplastic elastomer compositionally identical to the elastomer material of which the sheet claimed herein is comprised (*cf.*, patent claims 12/1/3 and 12/9). Further, upon reading the claim language "molded or formed product" in light of the supporting disclosure to ascertain the meaning and scope thereof, it is apparent that the patent is intended to cover species of the article here claimed; e.g., multi-layer laminates, leather sheets and waterproofing sheet materials are disclosed (col. 18, lines 65+ and col. 19, lines 9 and 12-13) in support of the molded/formed product embodiment claimed in the patent.

Alternatively, it would have been obvious to make a sheet or laminate from the olefin thermoplastic elastomer claimed in the '426 patent since the cited prior art references teach the general utility of olefinic thermoplastic elastomers, in partially or fully crosslinked state, in calender molding and for forming layered products (Kinoshita, col. 2, ll. 24-28 and col. 12, ll. 1-5 and 28-30) and laminated products in conjunction with a polyolefin resin (Itoh, paragraphs 0096 and 0161-0162).

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Given an expectation of the patented olefin thermoplastic elastomer possessing equivalent utility, it would have been obvious to use that elastomer to make a sheet or laminate and thereby arrive at the presently claimed invention.

Claims 2-7 are deemed free of the prior art.


The following is a statement of reasons for the indication of allowable subject matter: Applicants' claim an olefinic thermoplastic elastomer sheet composed of an elastomer material comprising an olefin random copolymer obtained by copolymerizing ethylene, an α -olefin having 3 to 10 carbon atoms and an unsaturated monomer having a functional group, and optionally a non-conjugated diene, and a metal ion for crosslinking the olefin random copolymer, wherein the unsaturated monomer having a functional group is a functional cyclic compound represented by a defined formula (1). Examiner has not found this subject matter in the prior art.

Any inquiry concerning this communication should be directed to Examiner F. M. Teskin whose telephone number is (571) 272-1116. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The appropriate fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


FRED TESKIN
PRIMARY EXAMINER
1713

FMTeskin/03-17-06